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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,190	12/22/2000	Timo Kinnunen	042933/301932	8071
826 7590 01/11/2007 ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER HASHEM, LISA	
			ART UNIT	PAPER NUMBER
			2614	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/11/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/742,190

Applicant(s)

KINNUNEN ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-14 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2, 5-14, and 23-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

FINAL DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Regarding claim 13, the word "means" is preceded by the word(s) "wireless network interface" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 5-8, 10, 12-14, and 23-25, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,263,201 by Hashimoto et al in view of Gerszberg.

Regarding claim 1, Hashimoto discloses a communication device (e.g. PC; Fig. 1: 51a-51f; col. 4, lines 34-57) including a messaging user interface (Figs. 7-11), the interface being configured for:

selecting a component for inclusion in a message (Fig. 11; col. 9, lines 16-60),

location conditions under which the message may be opened by a device of a recipient (col. 8, line 65 – col. 9, line 15; col. 9, lines 37-44; col. 10, lines 20-67; col. 11, lines 27-36; Fig. 10),

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and storing said message together with a message header holding the location conditions under which the message may be opened by the device of the recipient in a memory of a device (Fig. 12; col. 9, line 61 – col. 10, line 2; Figs. 15a and 15b).

Hashimoto clearly discloses storing said component in a database (Fig. 1, 16). However, Hashimoto does not disclose storing said component in the communication device.

Gerszberg discloses a communication device (Fig. 5; Fig. 1: 10, 130; col. 3, lines 11-16) including a messaging user interface (Fig. 5), the interface being configured for: selecting a component (e.g. object) for inclusion in a message (col. 8, line 7 – col. 9, line 16; col. 11, lines 39-57), selecting at least one of time and date conditions under which the message may be opened by a device of a recipient (e.g. caller) (col. 6, lines 42-57; col. 9, lines 17-30; col. 10, line 33 – col. 11, line 4) and storing said component as a message together at least one of time and date conditions under which the message may be opened by the device of the recipient in the communication device (Fig. 3B, 173; col. 6, lines 38-41; col. 8, lines 7-12; col. 11, lines 39-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Hashimoto to include storing said component in the communication device as taught by Gerszberg. One of ordinary skill in the art would have been lead to make such a modification to store the message locally on the communication device to provide a copy of the message that is sent to the recipient.

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Regarding claim 2, a device as claimed in claim 1, wherein Hashimoto further discloses in which the message header further contains information descriptive of content of the message (Fig. 12; col. 9, line 61 – col. 10, line 2).

Regarding claim 5, a device as claimed in claim 1 mentioned above, wherein Gerszberg further discloses the message includes a plurality of components and associated presentation files (col. 8, line 7 – col. 10, line 5).

Regarding claim 6, a device as claimed in claim 1 mentioned above, wherein Gerszberg further discloses in which at least one component is a multimedia file (col. 8, line 7 – col. 10, line 5).

Regarding claim 7, a device as claimed in claim 1 mentioned above, wherein Gerszberg further discloses the device is configured for creating a presentation file associated with said component, said file being stored with said message (col. 8, line 7 – col. 10, line 5; col. 11, lines 39-57).

Regarding claim 8, a device as claimed in claim 7 mentioned above, wherein Gerszberg further discloses the presentation file contains parameters relating a size and position of a component comprising a video image (col. 8, lines 7-53).

Regarding claim 10, a device as claimed in claim 7 mentioned above, wherein Gerszberg further discloses the presentation file contains parameters relating to a color and font of a component inherently comprising a text string (col. 8, lines 7-53).

Regarding claim 12, a device as claimed in claim 1 mentioned above, wherein Hashimoto further discloses the device is configured for formatting the message as an email (Fig. 13; col. 9, line 61 – col. 10, line 2; col. 10, lines 5-19).

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Regarding claim 13, a device as claimed claim 1 mentioned above, wherein Gerszberg further discloses including wireless network interface means (col. 4, lines 35-48; col. 4, line 58 – col. 5, line 18).

Regarding claim 14, a device as claimed in claim 1, wherein Gerszberg further discloses the device is a radio telephone (e.g. a videophone that uses a radio frequency interface) (col. 4, lines 35-44; col. 4, line 58 – col. 5, line 18; col. 5, lines 24-30).

Regarding claim 23, Hashimoto discloses a method comprising:
selecting a component for inclusion in a message (Figs. 7-11) at a communications device (e.g. PC; Fig. 1: 51a-51f) (col. 4, lines 34-57; col. 9, lines 16-60);
selecting location conditions under which the message may be opened by a device of a recipient (col. 8, line 65 – col. 9, line 15; col. 9, lines 37-44; col. 10, lines 20-67; col. 11, lines 27-36; Fig. 10); and
storing said component as a message together with a message header holding the location conditions under which the message may be opened by the device of the recipient in a memory of a device (Fig. 12; col. 9, line 61 – col. 10, line 2; Figs. 15a and 15b).

Hashimoto clearly discloses storing said component in a database (Fig. 1, 16). However, Hashimoto does not disclose storing said component in the communication device.

Gerszberg discloses a communication device (Fig. 5; Fig. 1: 10, 130; col. 3, lines 11-16) including
a messaging user interface (Fig. 5),
the interface including means for selecting a component (e.g. object) for inclusion in a message (col. 8, line 7 – col. 9, line 16; col. 11, lines 39-57),

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means for selecting at least one of time and date conditions under which the message may be opened by a device (e.g. videophone-enabled telephone) of a recipient (e.g. caller) (col. 6, lines 42-57; col. 9, lines 17-30; col. 10, line 33 – col. 11, line 4) and

means for storing said component as a message together at least one of time and date conditions under which the message may be opened by the device of the recipient in the communication device (Fig. 3B, 173; col. 6, lines 38-41; col. 8, lines 7-12; col. 11, lines 39-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hashimoto to include storing said component in the communication device as taught by Gerszberg. One of ordinary skill in the art would have been lead to make such a modification to store the message locally on the communication device to provide a copy of the message that is sent to the recipient.

Regarding claim 24, the method of claim 23, wherein Gerszberg further discloses creating a presentation file associated with said component, said file being stored with said message (col. 8, line 7 – col. 10, line 5; col. 11, lines 39-57).

Regarding claim 25, the method of claim 24, wherein Gerszberg further discloses creating the presentation file comprises creating a file including parameters relating a size and position of a component comprising a video image (col. 8, lines 7-53).

Regarding claim 27, the method of claim 24, wherein Gerszberg further discloses creating the presentation file comprises creating a file including parameters relating to a color and font of a component inherently comprising a text string (col. 8, lines 7-53).

Regarding claim 29, the method of claim 23, wherein

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Hashimoto further discloses formatting the message as an email (Fig. 13; col. 9, line 61 – co. 10, line 2; col. 10, lines 5-19).

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto in view of Gerszberg as applied to claim 7, and in further view of Jennings.

Regarding claim 9, a device as claimed in claim 7 mentioned above, wherein Gerszberg further discloses the presentation file contains a component comprising an audio recording (col. 8, lines 33-49).

Hashimoto in view of Gerszberg do not disclose parameters relating to a volume of an audio recording.

Jennings discloses a communication device (Fig. 1, 106) including a messaging user interface, the interface configured for selecting a component for inclusion in a message, selecting conditions under which the message may be opened by a device of a recipient (col. 1, lines 32-39; col. 2, lines 36-40; col. 4, lines 5-10; col. 4, line 53 – col. 5, line 14) and storing said component as a message together with a message header in a memory of the communication device (see Abstract; col. 2, line 65 – col. 3, line 36). Wherein Jennings further discloses the presentation file contains parameters relating to a volume of a component comprising an audio recording (col. 1, lines 11-30; col. 4, line 48 – col. 5, line 34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Hashimoto in view of Gerszberg to include parameters relating to a volume of an audio recording as taught by Jennings. One of ordinary skill in the art would have been lead to make such a modification to allow a sender to modify or adjust the volume of the audio recording before sending it to a recipient.

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6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto in view of Gerszberg as applied to claim 1, and in further view of Jennings.

Regarding claim 11, a device as claimed in claim 1 mentioned above, wherein Hashimoto in view of Gerszberg do not disclose the device is configured for formatting the message as an attachment to a short text message.

Jennings discloses a communication device (Fig. 1, 106) including a messaging user interface, the interface configured for selecting a component for inclusion in a message, selecting conditions under which the message may be opened by a device of a recipient (col. 1, lines 32-39; col. 2, lines 36-40; col. 4, lines 5-10; col. 4, line 53 – col. 5, line 14) and storing said component as a message together with a message header in a memory of the communication device (see Abstract; col. 2, line 65 – col. 3, line 36). Wherein Jennings further discloses means for formatting the message as an attachment to a short text message (see Abstract; col. 5, lines 35-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Hashimoto in view of Gerszberg to include means for formatting the message as an attachment to a short text message as taught by Jennings. One of ordinary skill in the art would have been lead to make such a modification to allow a sender to attach the message to a short text message.

7. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto in view of Gerszberg as applied to claim 26, and in further view of Jennings.

Regarding claim 26, the method of claim 24, wherein

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Gerszberg further discloses creating the presentation file comprises creating a file including a component comprising an audio recording (col. 8, lines 33-49).

Hashimoto in view of Gerszberg do not disclose parameters relating to a volume of an audio recording.

Jennings discloses a communication device (Fig. 1, 106) including a messaging user interface, the interface configured for selecting a component for inclusion in a message, selecting conditions under which the message may be opened by a device of a recipient (col. 1, lines 32-39; col. 2, lines 36-40; col. 4, lines 5-10; col. 4, line 53 – col. 5, line 14) and storing said component as a message together with a message header in a memory of the communication device (see Abstract; col. 2, line 65 – col. 3, line 36). Wherein Jennings further discloses the creating the presentation file comprises creating a file including parameters relating to a volume of a component comprising an audio recording (col. 1, lines 11-30; col. 4, line 48 – col. 5, line 34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hashimoto in view of Gerszberg to include parameters relating to a volume of an audio recording as taught by Jennings. One of ordinary skill in the art would have been lead to make such a modification to allow a sender to modify or adjust the volume of the audio recording before sending it to a recipient.

8. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto in view of Gerszberg as applied to claim 23, and in further view of Jennings.

Regarding claim 28, the method of claim 23, wherein Hashimoto in view of Gerszberg do not disclose formatting the message as an attachment to a short text message.

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Jennings discloses a communication device (Fig. 1, 106) including a messaging user interface, the interface configured for selecting a component for inclusion in a message, selecting conditions under which the message may be opened by a device of a recipient (col. 1, lines 32-39; col. 2, lines 36-40; col. 4, lines 5-10; col. 4, line 53 – col. 5, line 14) and storing said component as a message together with a message header in a memory of the communication device (see Abstract; col. 2, line 65 – col. 3, line 36). Wherein Jennings further discloses means for formatting the message as an attachment to a short text message (see Abstract; col. 5, lines 35-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hashimoto in view of Gerszberg to include means for formatting the message as an attachment to a short text message as taught by Jennings. One of ordinary skill in the art would have been lead to make such a modification to allow a sender to attach the message to a short text message.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 2, 5-14, and 23-29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

12. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

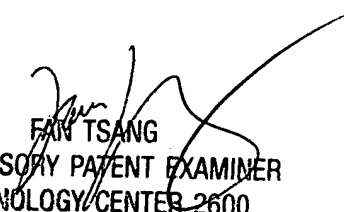
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lh
December 29, 2006


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